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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/704,306	11/02/2000	James P. Beck	PH-7032	4919

7590 04/21/2005

MICHEAL L. GOLDMAN
NIXON PEABODY
CLINTON SQUARE, P.O. BOX 31051
ROCHESTER, NY 14603

EXAMINER

COLEMAN, BRENDA LIBBY

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/704,306

Applicant(s)

BECK ET AL.

Examiner

Brenda L. Coleman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 51-85 and 90-92 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 51-55, 60, 63, 66, 84 and 85 is/are rejected.
- 7) ☒ Claim(s) 56-59, 61, 62, 64, 65, 67-83 and 90-92 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 51-85 and 90-92 are pending in the application.

This action is in response to applicant's amendment filed January 25, 2005.

Claims 51 and 73 have been amended.

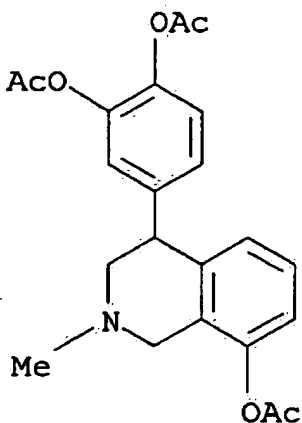
Response to Amendment

Applicant's amendments and arguments filed January 25, 2005 have been fully considered with the following effect:

1. The applicant's amendments and arguments are sufficient to overcome the 35 U.S.C. § 112, second paragraph rejection of claims 51-59, 66-72, 76-78, 84, 85 and 90-92 labeled paragraph 3b) maintained in the last office action, which is hereby **withdrawn**.
2. The applicant's amendments and arguments are sufficient to overcome the 35 U.S.C. § 112, first paragraph rejection of claims 51-55, 60-64, 66-72, 76-78, 84, 85 and 90-92 labeled paragraph 4) in the last office action, which is hereby **withdrawn**.
3. The applicant's amendments and arguments are sufficient to overcome the 35 U.S.C. § 112, second paragraph rejections of claims 51-55, 60-64, 66-73, 76-78, 84, 85 and 90-92 labeled paragraph 5) in the last office action, which are hereby **withdrawn**.
4. With regards to the 35 U.S.C. § 102, anticipation rejection of claims 51-55, 60, 63, 66, 84 and 85 are rejected under 35 U.S.C. 102(b) as being anticipated by BRENNER et al., U.S. Patent No. 4,340,600. The applicants stated that Brenner fails to teach the limitation "wherein if R^3 is $-S(O)_nR_{12}$, n cannot be 0, and wherein R^3 is $-OR^{11}$,

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R¹¹ cannot be hydrogen" and that "the specific substituents required by the separately claimed class of compounds of IA-F are not taught by Brenner". However, Brenner teaches the compounds, compositions and method of use of the compounds of formula IB where R³ is -OR¹¹ and R¹¹ is (CO)R¹³ where R¹³ is methyl, i.e. OAc, R¹, R², R⁴, R⁷ and R⁸ are H, R⁵ and R⁶ are each -OR¹¹ and R¹¹ is -C(O)R¹³ where R¹³ is methyl as shown Example 10 and the following formula.



Claims 51-55, 60, 63, 66, 84 and 85 are rejected under 35 U.S.C. 102(b) as being anticipated by BRENNER et al., U.S. Patent No. 4,340,600, for reasons of record and stated above.

Claim Objections

5. Claims 56-59, 61, 62, 64, 65, 67-83 and 90-92 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda L. Coleman whose telephone number is 571-272-0665. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Brenda L. Coleman
Primary Examiner Art Unit 1624
April 17, 2005